

REMARKS

Claims 38, 40-43, 46-51, 53-61, 63, 64, 66, 68, 72-77, 79-85, 87, and 88 were pending in this application. This Amendment will cancel claims 41-43, and hereafter treats rejections of such claims as moot. Applicants expressly reserve the right to pursue protection of any or all of the canceled subject matter in a subsequent application. This Amendment also will amend claims 38, 57-59, and 63. Support for these amendments is discussed below as needed. No new matter is introduced by these claim amendments, and no new issues are raised.

Entry of the amendments after final action is appropriate because the amendments are believed to place the claims in a condition for allowance. Moreover, entry of the amendment will reduce the number of claims and remove canceled subject matter from consideration, and, thereby, simplify issues for appeal.

Upon entry of the foregoing claim amendments, **claims 38, 40, 46-51, 53-61, 63, 64, 66, 68, 72-77, 79-85, 87, and 88 will be pending in this application.** Entry of the claim amendments herein and reconsideration of the pending rejections are requested.

Claim Rejections under 35 U.S.C. §112, 1st paragraph:

Claims 38, 40-43, 46-51 and 53-61 have been rejected under 35 U.S.C. §112, 1st paragraph because the term “multi-subunit protein complex” allegedly is new matter. In particular, the Office alleges that “the term ‘multi-subunit protein complex’ is given a meaning in the claims that is distinct from that in the specification.” Applicants traverse this rejection. Nevertheless, to facilitate prosecution of this application, claim 38 (and, therefore, its dependent claims 46-51 and 53-61) has (have) been amended to remove the disputed phrase. Thus, this rejection is moot and Applicants request that it be withdrawn.

Claim Rejections under 35 U.S.C. §112, 2nd paragraph:

Claims 63, 64, 66, 68, 72-77, 79-85, 87 and 88 have been rejected under 35 U.S.C. §112, 2nd paragraph because the phrase “the test compound” in claim 63 allegedly lacks antecedent basis. Applicants have amended claim 63 so that the first occurrence of the disputed phrase

recites “a test compound.” In view of this amendment, Applicants request that the rejection be withdrawn.

Claim Rejections under 35 U.S.C. §102(e):

Claims 38, 40, 43, 48, 53 and 57-61 have been rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Wong *et al.* (U.S. Pat. No. 6,465, 629) as evidenced by Wang *et al.*, *Cell Growth and Differentiation*, 1(5):233-238, 1990, and Dahiya *et al.*, *Mol. Cell. Biol.*, 20(18):6799-6805. Applicants traverse this rejection.

Wong *et al.* fails to teach, as it must, all of the elements of the claim. Wong *et al.* does not describe, at least, “a method to identify a compound that modulates a direct interaction between one or more subunits of a SWI/SNF chromatin remodeling complex and a nucleic acid regulatory protein DNA binding domain peptide” (emphasis added). Wong *et al.* allegedly describes “a method of screening drugs that modulate the binding of Rb with BRG1, a chromatin remodeling subunit of SWI/SNF” (Office action at page 4). The retinoblastoma protein (Rb) is not a “nucleic acid regulatory protein DNA binding domain peptide” and Wong *et al.* does not teach that it is.

The Office cites several additional references (*e.g.*, Wang *et al.* and Dahiya *et al.*) apparently to “[e]xplain the meaning of a term [(Rb)] used in the primary reference” (MPEP §2131.01). However, neither Wang *et al.* nor Dahiya *et al.* explain that Rb is a “nucleic acid regulatory protein DNA binding domain peptide,” and, in fact, make the case against this meaning. As is well known in the art, DNA-binding nucleic acid regulatory proteins bind specific nucleic acid sequences. The Wang *et al.* paper admits that (i) Rb demonstrated “sequence-nonspecific DNA binding activity” (see second sentence of Abstract; emphasis added); and (ii) “[Rb] cDNA did not demonstrate regions homologous to known DNA-binding domains” (bottom of column 2 on page 233). Hence, Rb is not DNA-binding nucleic acid regulatory protein. Dahiya *et al.* also does not define Rb in the manner contended by the Office.

Nevertheless, merely to facilitate prosecution of this application, claim 38 (and its dependent claims 40, 48, 53 and 57-61) has (have) been amended to recite, in relevant part,

“... a nucleic acid regulatory protein zinc finger DNA binding domain peptide . . .” (emphasis added). Even if Rb specifically bound DNA (which is not admitted), it does not do so via a zinc finger DNA binding domain; thus, neither Rb nor its fragments could be characterized as

“... a nucleic acid regulatory protein zinc finger DNA binding domain peptide . . .”

Accordingly, Wong *et al.* can not anticipate claim 38 and its dependent claims because Wong *et al.* does not teach all of the elements of these claims (even if “evidenced by” Wang *et al.* and Dahiya *et al.*). Applicants respectfully request that this rejection be withdrawn.

Applicants specifically reserve the right to pursue in a separate application any subject matter canceled by an amendment of claim 38 herein.

Claim Rejections under 35 U.S.C. §103(a):

Claims 47 and 53 have been rejected under 35 U.S.C. §103(a) as allegedly being obvious in light of Wong *et al.*, as evidenced by Wang *et al.* and Dahiya *et al.*, in view of Strober *et al.*, *Mol. Cell. Biol.*, 16(4):1576-1583, 1996. Applicants traverse this rejection.

In order to establish a *prima facie* case of obviousness, the Office must (among other things) provide a reference or combination of references that teach all of the elements of the rejected claim(s) (MPEP §2142). Claims 47 and 53 depend from claim 38. Wong *et al.* does not teach all of the elements of claim 47 and 53 (*e.g.*, “... a nucleic acid regulatory zinc finger DNA binding domain peptide . . .”) for all of the same reason this reference does not teach all of the elements of claim 38, as discussed above in detail. Neither Wang *et al.*, Dahiya *et al.* or Strober *et al.* describe “... a nucleic acid regulatory zinc finger DNA binding domain peptide . . .”; thus, none of such references can make up for the deficiencies in Wong *et al.* Accordingly, a *prima facie* case of obviousness has not been established, and this rejection should be withdrawn.

CONCLUSION

It is respectfully submitted that the present claims are in a condition for allowance. If it may further issuance of these claims, the Examiner is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By Debra A. Gordon
Debra A. Gordon, Ph.D.
Registration No. 54,128

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 226-7391
Facsimile: (503) 228-9446